

Remarks

The present application includes claims 1-21. Claims 1-21 have been rejected by the Examiner.

Claims 1-21 were rejected under 35 U.S.C. 103(a) as unpatentable over Jasper et al. (U.S. Patent No. 6,702,670).

Applicant respectfully traverses the Examiner's rejection for at least the following reasons.

In Jasper, if a player wins the first game, the player is given the opportunity to **wager those first game winnings** on a second "double-up" bonus game. See, e.g., Abstract; Fig. 1; col. 1, lines 62-65; col. 3, lines 13-16. If the player loses the bonus game, the player **loses the winnings from the first game**. See, e.g., Abstract; Fig. 1; col. 1, lines 62-65; col. 3, lines 20-25. If the player wins the bonus game, the player's winnings are doubled. See, e.g., Abstract; Fig. 1; col. 2, lines 1-4; col. 3, lines 18-20. The player can continue to play the bonus game until the player either loses a bonus game (at which point, all of the player's winnings from the first game and bonus game are lost), or cashes out with his/her winnings. See, e.g., Abstract; Fig. 1; col. 2, lines 1-5; col. 3, lines 25-28. Thus, in Jasper, a player is **not** guaranteed a prize in the bonus game, and, in fact, could **also lose** the winnings he/she had gained in the base game. The Jasper bonus game has the potential to double the player's winnings but also the potential to leave the player with nothing.

In the presently pending claims, the feature is separate from the base game. The player's winnings from the base game are unaffected by the feature. Also, the player

does not have to wager the winnings from the base game in order to participate in the feature. Additionally, the player is guaranteed at least one win from the feature, so the player will be awarded a base game prize and a feature prize, as recited in the pending claims. Furthermore, the player is able to keep at least some of what has been won in subsequent games or stages of the feature, even if the player loses. None of these ideas are taught by Jasper. None of these ideas are suggested by Jasper without relying upon an improper hindsight analysis.

It is well established that an examiner is not permitted to use an improper hindsight reconstruction of the claimed invention in rejecting the claims. Use of hindsight analysis has been specifically condemned by the Federal Circuit:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification ... Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This Court had previously stated that “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

In Re John Fritch, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992). See also *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1135, 1143 n.5, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); MPEP 2141.

The limitations recited in the pending claims go well beyond an “obvious” design choice to allow a consolation prize. The claims recite a particular configuration, a particular sequence of base game and feature, and a particular system/method for rewarding and entertaining a player that goes well beyond an “obvious” design choice to

allow a consolation prize. The Applicant respectfully submits that claims 1-21 represent novel, useful and non-obvious improvements over the prior art of record and should be allowable. As discussed further below, if the Examiner is asserting that the particular system and methods claimed in the present application are either inherent or well known (i.e., taking official notice), then the Examiner is asked to provide further evidence to which the Applicant can respond. As it now stands, such evidence appears to be lacking.

Furthermore, with respect to the dependent claims, Jasper fails to teach or reasonably suggest use of a controller to determine probability of success as the player continues to play the feature, as recited in claim 6. Jasper similarly fails to disclose a controller to determine a subsequent prize, as recited in claim 7. Further use of the controller, not shown by Jasper, is recited in claims 8 and 9. Similar limitations, also not disclosed by Jasper for at least the same reasons, are found in claims 17-20.

Thus, for at least the reasons recited above, the Applicant respectfully submits that claim 1-21 should be allowable over the cited art of record.

Claims 6-9 and 17-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Jasper and further in view of official notice.

As discussed above, Jasper fails to teach or reasonably suggest the limitations recited in claims 1-21. However, the Examiner takes Official Notice as follows:

12. Regarding claims 9 and 20, examiner takes official notice that all games must have a calculated percentage sheet whereas the pay table and game expected win is calculated. These odd calculations are not novel but required for the implementation of any gaming device, and vary according to the game playing features. It would not only be obvious but necessary for one having ordinary skill in the art, at the time of the applicant's invention, to incorporate these paytables and calculations in the design and reporting of these machines. One would be motivated to do so to comply with gaming regulations. Please review documentation (Nevada Gaming Commission, Minimum Internal

Controls Standards, and the University of Reno Class Slots 101), not supplied but cited references as support for official notice.

13. Regarding claims 6-8, and 17-19, Jasper et al. teaches that the probability of the game feature (bonus rounds) is different from the standard game and can vary in many ways. (Col 7:8-11, Col 8:1-20). The examiner takes official notice that the choice to pay more in one bonus and less in another is clearly a design choice and that the game would not be affected by these differences as admitted by applicant in the effort of claiming 3 different embodiments for the bonuses in claims 6, 7, and 8.

The Applicant respectfully traverses the Examiner's assertion for at least the reasons stated above and as further provided below.

If the Examiner's assertions are based on the personal knowledge of the Examiner, then under MPEP § 2144.03(C) and 37 C.F.R. § 1.104(d)(2), the Examiner's assertions must be supported by an affidavit from the Examiner. According to MPEP § 2144.03(A), Official Notice, without supporting references, should only be asserted when the subjects asserted to be common knowledge are "capable of instant and unquestionable demonstration as being well-known." That is, the subjects asserted must be of "notorious character" under MPEP § 2144.03(A).

However, the Applicant respectfully submits that the subject matter of the Examiner's assertion of Official Notice is not well-known in the art as evidenced by the searched and cited prior art. The Applicant respectfully submits that the Examiner has performed "a thorough search of the prior art," as part of the Examiner's obligation in examining the present application under MPEP § 904.02. Additionally, the Applicant respectfully submits that the Examiner's searched and cited references found during the Examiner's thorough and detailed search of the prior art are indicative of the knowledge commonly held in the art. However, in the Examiner's thorough and detailed search of the relevant prior art, none of the prior art taught or suggested the subject matter of the

Examiner's assertion of Official Notice. That is, the Examiner's thorough and detailed search of the prior art has failed to yield any mention of the teachings that the Examiner is asserting as widely known in the art. The Applicant respectfully submits that if the subject matter of the Examiner's assertion of Official Notice had been of "notorious character" and "capable of instant and unquestionable demonstration as being well-known" under MPEP § 2144.03(A), then the subject matter would have appeared to the Examiner during the Examiner's thorough and detailed search of the prior art.

If the Examiner had found any teaching of relevant subject matter, the Examiner would have been obligated to list the references teaching the relevant subject matter and make a rejection. Consequently, the Applicant respectfully submits that the prior art does not teach the subject matter of the Examiner's assertion of Official Notice and respectfully traverses the Examiner's assertion of Official Notice.

As stated above, the Applicant respectfully traverses the Examiner's assertions of Official Notice and submits that the subject matter is not of such "notorious character" that it is "capable of instant and unquestionable demonstration as being well-known." Under MPEP 2144.03, the Examiner is now obligated to provide a reference(s) in support of the assertion of Official Notice if the Examiner intends to maintain any rejection based on the assertion of Official Notice. Additionally, the Applicant respectfully requests the Examiner reconsider the assertion of Official Notice and provide to Applicant any basis for the Examiner's assertion of Official Notice. The Jasper reference provides none of the teachings alleged as well known and necessary by the Examiner. Whereas games must have a payable, the recitation of particular probability calculations for success and for prize determination and use of the controller recited in claims 6-8 and 17-19 are not

necessary in that form and are not well known in the art. Furthermore, the particular equations cited in claims 9 and 20, which add further limitations to claims 8 and 19, respectively, are neither well known nor necessary in all games. The Applicant respectfully submits that these limitations establish a new way of game play, determination of success, and awarding of a prize. If the Examiner has any questions, the Examiner is invited and encouraged to contact the Applicant at the number below for further discussion.

Additionally, according to MPEP § 2112, an examiner must provide rationale or evidence tending to show inherency. The fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency of that result. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Examiner has not provided why it necessarily flows from Jasper that success probabilities and prize awards are necessarily determined as outlined in claims 6-9 and 17-20. Success and prize award determination may occur in a variety of ways. It does

not necessarily flow from Jasper that the probabilities and calculations occur in the ways recited in the pending claims using the components recited.

Thus, the Applicant respectfully traverses the Examiner's assertions of Official Notice and/or inherency.

For at least these reasons, the Applicant respectfully submits that at least claims 6-9 and 17-20 should be allowable.

Claims 1 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Jasper in view of Bennett (U.S. Patent No. 6,835,132).

As discussed above, Jasper fails to teach or reasonably suggest the limitations recited in claims 1-21. Bennett provides a single phase feature game wherein a single event occurs, with the outcome determined by the player. See, e.g., Abstract. For example, a skydiver jumps from a plane, and the player controls the point at which the skydiver pulls the rip cord. If the rip cord is pulled in time to open the parachute and save the skydiver, the player wins a prize dependent upon how close the ground the cord was pulled, If the parachute is opened too late to prevent the skydiver from hitting the ground, then a consolation prize may be awarded.

Bennett does not provide the combination of base game and feature series (multiple games or phases in a feature based on player choice and outcome) recited in claims 1 and 12 of the present application. Bennett does not provide the winning/losing outcome and associated prize determination recited in claims 1 and 12.

Therefore, for at least these reasons, the Applicant respectfully submits that claims 1 and 12 and their dependent claims 2-11 and 13-21 should be allowable over the cited art of record.

The Applicant also submits that the pending claims 1-21 should be allowable over the art cited in the present action but not relied upon by the Examiner in rejecting the pending claims.


CONCLUSION

It is submitted that the present application is in condition for allowance and a Notice of Allowability is respectfully solicited. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any additional fees or credit overpayment to the Deposit Account of MHM, Account No. 13-0017.

Respectfully submitted,

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Christopher N. George
Reg. No. 51,728

McAndrews, Held & Malloy, Ltd.
500 W. Madison Street
34th Floor
Chicago, IL 60661
Phone (312) 775-8000
Fax (312) 775-8100